

Case IPR2024-01312
U.S. Patent No. 11,697,028

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIOFRONTERA INC., BIOFRONTERA BIOSCIENCE GMBH,
BIOFRONTERA PHARMA GMBH, AND BIOFRONTERA AG
Petitioner

v.

DUSA PHARMACEUTICALS, INC.
Patent Owner

Case IPR2024-01312

U.S. Patent No. 11,697,028

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. APPLICABLE LEGAL STANDARD	1
III. THE NEW OPINION PARAGRAPHS (EXHIBIT 1026) SHOULD BE EXCLUDED UNDER FEDERAL RULE OF EVIDENCE 403	4
IV. THE ITC TESTIMONY (EXHIBIT 1031) SHOULD BE EXCLUDED UNDER FEDERAL RULE OF EVIDENCE 403	10
V. CONCLUSION.....	14

TABLE OF AUTHORITIES

	<u>Page(s)</u>
 Cases	
<i>Duration Media LLC v. Rich Media Club LLC</i> , IPR2023-00953, Paper 74 (PTAB 2024).....	3
<i>Henny Penny Corporation v. Frymaster LLC</i> , 938 F.3d 1324 (Fed. Cir. 2019)	2
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	1, 2
<i>Interactive Communications International, Inc. v. Blackhawk Network Inc.</i> , IPR2023-01235, Paper 34 (PTAB 2025).....	3
<i>SAS Institute, Inc. v. Iancu</i> , 54 U.S. 357 (2018).....	1
<i>Wasica Finance GmbH v. Continental Automotive Systems, Inc.</i> , 853 F.3d 1272 (Fed. Cir. 2017)	2
 Statutes	
35 U.S.C. § 312(a)(3).....	1, 2, 3
37 C.F.R. § 42.64(c).....	1
 Other Authorities	
Consolidated Trial Practice Guide	1, 3
 Rules	
37 C.F.R. § 42.23(b)	2
CFR § 42.64(b)(1).....	4, 11
Federal Rule of Evidence 403	1, 10, 11

PATENT OWNER’S EXHIBIT LIST

EX #	DESCRIPTION
2001	Declaration of Dr. Jose Sasian
2002	<i>Curriculum Vitae</i> of Dr. Jose Sasian
2003	Complainant’s Initial Statement Regarding The Public Interest filed in ITC Investigation No. 337-TA-1411, dated June 25, 2024
2004	Australian Patent Application Publication No. AU 200143869 published September 6, 2001 to Eric Larsen entitled <i>Device and methods for the stimulation of body cells through electromagnetic radiation</i> (“Larsen Publication”)
2005	United States Trademark Serial No. 78214595 Statement of Use and correspondence for BEAUTYLIGHT (“BEAUTYLIGHT”)
2006	United States Patent No. 4,832,294 issued May 23, 1989 to John C. Eldem entitled <i>Portable I.V. Stand</i> (“the ’294 patent”)
2007	Inventor Tom Boyajian LinkedIn profile at https://www.linkedin.com/in/tom-boyajian-404286307/
2008	Inventor Mark Carota LinkedIn profile at https://www.linkedin.com/in/mark-c-366911a/
2009	Inventor Brian Mazejka LinkedIn profile at https://www.linkedin.com/in/brianmazejka/
2010	Lighting-Gallery.net – My lights/completely clear/uncoated Sylvania 28W T5 HE demonstration tube at https://www.lighting-gallery.net/gallery/displayimage.php?album=1601&pos=188&pid=211863
2011	Bourget, C. Michael, <i>An Introduction to Light-emitting Diodes</i> , HortScience, Vol. 43(7), pp. 1944-1946 (December 2008)
2012	United States Patent No. 6,979,101, issued December 27, 2005 to Christian Sauska et al., entitled <i>Fluorescent Lamp Providing Uniform Backlight Illumination for Displays</i> (“the ’101 patent”)
2013	Ndjiongue, Alain R. et al., <i>Visible Light Communications (VLC) Technology</i> , pp. 1-23 (June 2015)
2014	Technical Domestic Industry Claim Chart for U.S. Patent No. 11,697,028 (Ex. 10C Public Version) filed in ITC Investigation No. 337-TA-1411, dated July 9, 2024
2015	Declaration of Heather J Roberts, MD, FAAD
2016	<i>Curriculum Vitae</i> of Heather J Roberts, MD, FAAD
2017	https://www.levulanhcp.com/
2018	https://www.levulanhcp.com/how-to-use

EX #	DESCRIPTION
2019	https://www.levulanhcp.com/how-it-works
2020	https://www.levulanhcp.com/treatment-landscape
2021	https://www.levulanhcp.com/efficacy
2022	https://www.levulanhcp.com/assets/pdf/levulan-patient-brochure.pdf
2023	https://drheatherroberts.com/procedures-and-treatments/photodynamic-therapy-pdt-for-skin-cancer/
2024	https://www.mydrugrep.com/mobile-campaigns/Levulan_V13a_01a/space_requirements.html
2025	https://somalaser.com/dr-michael-ehrenreich-md-millburn-dermatologist/
2026	https://somalaser.com/blu-for-acne/
2027	https://somalaser.com/photodynamic-therapy/
2028	https://somalaser.com/photodynamic-therapy-for-actinic-keratoses-and-skin-cancer/
2029	https://somalaser.com/photodynamic-therapy-for-skin-conditions/
2030	https://somalaser.com/skin-conditions/actinic-keratosis/
2031	[RESERVED]
2032	[RESERVED]
2033	<i>In Re Certain Photodynamic Therapy Systems, Components Thereof, And Pharmaceutical Products Used In Combination With The Same</i> Investigation No. 337-TA-1411 (Order No. 18 – Construing Certain Claim Terms, dated March 4, 2025 (Public Version))
2034	<i>In Re Certain Photodynamic Therapy Systems, Components Thereof, And Pharmaceutical Products Used In Combination With The Same</i> Investigation No. 337-TA-1411 (Redacted Expert Report of Dr. Robert E. Grove, Ph.D. on behalf of Respondents, dated January 22, 2025)
2035	United States Patent No. 8,216,289 issued July 10, 2012 to Scott Lundahl, et al., entitled <i>Illuminator for Photodynamic Therapy</i> (“the ’289 patent”)
2036	<i>In Re Certain Photodynamic Therapy Systems, Components Thereof, And Pharmaceutical Products Used In Combination With The Same</i> Investigation No. 337-TA-1411 (Redacted Deposition Transcript of Dr. Robert E. Grove, taken February 26, 2025)
2037	BLU-U® Optical Specification
2038	<i>In Re Certain Photodynamic Therapy Systems, Components Thereof, And Pharmaceutical Products Used In Combination With The Same</i> Investigation No. 337-TA-1411 (Sun Pharma’s Redacted Final Validity Contentions dated December 18, 2024)

EX #	DESCRIPTION
2039	Redacted Deposition Transcript of Mark Baldyga in ITC Inv. No. 337-TA-1411, taken December 19, 2024
2040	Ex. 6 to Baldyga Deposition Transcript in ITC Inv. No. 337-TA-1411 (Marketing Presentation Slides)
2041	Ex. 5 to Baldyga Deposition Transcript in ITC Inv. No. 337-TA-1411 (Ameluz Marketing Materials)
2042	Ex. 4 to Baldyga Deposition Transcript in ITC Inv. No. 337-TA-1411 (RhodoLED® XL Trifold)
2043	RhodoLED® XL User Manual, Version 1.7SW G2
2044	“ <i>Biofrontera AG receives FDA-approval of the BF-RhodoLED® XL lamp,</i> ” GlobalNewswire, https://www.globenewswire.com/news-release/2021/10/22/2319235/0/en/Biofrontera-AG-receives-FDA-approval-of-the-BF-RhodoLED-XL-lamp.html , dated October 22, 2021
2045	“ <i>Biofrontera Announces the Launch of a New, FDA-Approved Red Light Source, the RhodoLED® XL Lamp,</i> ” BioSpace, https://www.biospace.com/biofrontera-announces-the-launch-of-a-new-fda-approved-red-light-source-the-rhodoled-xl-lamp , dated June 24, 2024
2046	“ <i>Biofrontera Inc. Announces 100 RhodoLED®XL Machines Now Placed in US Market,</i> ” GlobalNewswire, https://www.globenewswire.com/news-release/2024/12/23/3001296/0/en/Biofrontera-Inc-Announces-100-RhodoLED-XL-Machines-Now-Placed-in-US-Market.html , dated December 23, 2024
2047	“ <i>Biofrontera Inc. Reports Record Fiscal Year 2024 Financial Results and Provides a Business Update,</i> ” Biofrontera, Inc., dated March 21, 2025
2048	Declaration of Thomas Vander Veen
2049	Supplemental Declaration of Heather J Roberts, MD, FAAD
2050	Declaration of Dr. Nan Jokerst
2051	<i>Curriculum Vitae</i> of Dr. Nan Jokerst
2052	Excerpted Deposition Transcript of Mark Carota in ITC Inv. No. 337-TA-1411, taken December 5, 2024
2053	Excerpted Deposition Transcript of Thomas Boyajian in ITC Inv. No. 337-TA-1411, taken December 10, 2024
2054	“ <i>FDA Approves RhodoLED XL Lamp Red Light Source for Use in Actinic Keratosis Treatment,</i> ” Dermatology Times, dated July 2, 2024 https://www.dermatologytimes.com/view/icymi-fda-approves-rhodoled-xl-lamp-red-light-source-for-use-in-actinic-keratosis-treatment

EX #	DESCRIPTION
2055	Biofrontera Form 10-K, dated March 20, 2025
2056	BF-RhodoLED®, https://us.ameluz.com/hcp/activate-with-rhodoled-lamp/
2057	Biofrontera Q4 2024 Earnings Call Transcript
2058	<i>“Biofrontera Inc. Announces FDA Orange Book Listing of U.S. Patent for BF-RhodoLED® XL, Extends Protection of Ameuluz® PDT Through October 2040,”</i> BioSpace, dated March 14, 2022
2059	U.S. Pat. No.11,235,169 issued February 1, 2022 to Markus Osterloh, et al., entitled <i>Illumination Device for Photodynamic Therapy, Method for Treating a Skin Disease and Method for Operating an Illumination Device</i> (“the ’169 patent”)
2060	AMELUZ Prescribing Information, December 2021
2061	File History of U.S. Patent No. 11,446,512
2062	<i>“Actinic Keratosis,”</i> Cleveland Clinic, https://my.clevelandclinic.org/health/diseases/14148-actinickeratosis
2063	<i>“Actinic Keratosis: Diagnosis and Treatment”</i> American Academy of Dermatology Association, https://www.aad.org/public/diseases/skin-cancer/actinic-keratosistreatment
2064	<i>“Biofrontera Announces U.S. FDA Approval of Ameluz® and Activating BF-RhodoLED® Device for Treatment of Actinic Keratosis”</i> Biofrontera News Release, https://www.biofrontera.com/fileadmin/files/PDFs/Corporate_news/2016/EN/20160511 , May 11, 2016
2065	<i>“Biofrontera Bioscience GmbH,”</i> www.medicines.ie
2066	<i>“Biofrontera Inc. (BFRI) Q2 2024 Earnings Call Transcript”</i> https://seekingalpha.com/article/4714932-biofrontera-inc-bfri-q2-2024-earnings-call-transcript , August 15, 2024
2067	<i>“Biofrontera Inc. (BFRI) Q4 2023 Earnings Call Transcript”</i> https://finance.yahoo.com/news/biofrontera-inc-nasdaq-bfri-q4-132209594.html , March 18, 2024
2068	<i>“Biofrontera Inc. Reports First Quarter 2024 Financial Results and Provides a Business Update”</i> https://www.biospace.com/biofrontera-inc-reports-first-quarter-2024-financial-results-and-provides-a-business-update , May 15, 2024
2069	<i>“Biofrontera Inc. Reports Third Quarter and Nine-Month 2024 Financial results and Provides Business Update”</i> https://www.biospace.com/press-releases/biofrontera-inc-reports-third-quarter-and-nine-month-2024-financial-results-and-provides-business-update , November 14, 2024

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2070	Biofrontera Inc., Annual Report Pursuant to Section 13 or 15(d) of the Securities Exchange Act of 1934 for the Fiscal Year Ended December 31, 2023 (Form 10-K)
2071	“Biofrontera Pharma GmbH,” https://www.medicines.org.uk/emc/product/3158/smpc
2072	“ <i>Photodynamic Therapy Market Size, Share, and Trends 2025 to 2034</i> ” Precedence Research, https://www.precedenceresearch.com/photodynamic-therapy-market
2073	“ <i>Photodynamic Therapy Market to Grow by USD 2.35 Billion (2024-2028), Driven by Rising Cancer Prevalence, AI-Powered Report Highlights Market Trends – Technavio</i> ” PR Newswire, https://www.prnewswire.com/news-releases/photodynamic-therapy-market-to-grow-by-usd-2-35-billion-2024-2028-driven-by-rising-cancer-prevalence-ai-powered-report-highlights-market-trends---technavio-302305410.html , November 14, 2024
2074	“ <i>Photodynamic Therapy</i> ” Mayo Clinic https://www.mayoclinic.org/tests-procedures/photodynamic-therapy/about/pac-20385027
2075	“ <i>U.S. Actinic Keratosis Treatment Market Size Industry Analysis 2033</i> ” BioSpace, https://www.biospace.com/u-s-actinic-keratosis-treatment-market-size-industry-analysis-2033 , April 25, 2024
2076	“ <i>Why Levulan® Kerastick® + BLU-U®</i> ,” https://www.levulan.com/why-levulan-kerastick
2077	Tim Smith, “ <i>FDA-Approved Red-Light LED Lamp Released for Patients With Actinic Keratosis</i> ,” AJMC, https://www.ajmc.com/view/fda-approved-red-light-led-lamp-released-for-patients-with-actinic-keratosis , June 28, 2024
2078	ROTH MKM, Biofrontera, Inc, “BFRI 3Q24: Hurricane Milton Impacted 3Q Revs, But 4Q Is Already Compensating,” Jonathan Aschoff, Ph.D., November 14, 2024
2079	FDA letter regarding BLU-U Model 4170E, dated May 1, 2025
2080	“ <i>Gas Discharge Tubes – Introduction</i> ”, G3YNH.info, https://www.g3ynh.info/disch_tube/intro.html
2081	[RESERVED]
2082	IPR2024-00874 EX1003 Declaration Eric Bretschneider, Ph.D.
2083	[RESERVED]
2084	Deposition Transcript of Robert E. Grove, Ph.D., taken May 13, 2025

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2085	Dermatology Times, “ <i>FDA Approves Sun Pharma’s New LED BLU-U Device for AK</i> ”, May 16, 2025 https://www.dermatologytimes.com/view/fda-approves-sun-pharma-s-new-led-blu-u-device-for-ak
2086	Declaration of Raymond Habbaz in Support of Motion for Admission <i>Pro Hac Vice</i>
2087	Deposition Transcript of Robert E. Grove, Ph.D., taken September 11, 2025
2088	Dr. Grove’s Deposition Exhibit 2088 (Excerpted Redacted Deposition Transcript of Hermann Luebbert in ITC Inv. No. 337-TA-1411, taken December 13, 2024)

I. Introduction

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Sun Pharmaceutical Industries, Inc. (“Patent Owner” or “Sun Pharma”) moves to exclude ¶¶12-17 and 19 (the “New Opinion Paragraphs”) of EX1026 (Supplemental Declaration of Dr. Grove) and 591:5-7 and 592:2-8 (the “ITC Testimony”) of EX1031 (ITC Trial Transcript Day 3) under Federal Rule of Evidence (FRE) 403 because they introduce new theories and opinions that were not included in the Petition.

II. Applicable Legal Standard

The “petitioner’s petition...is supposed to guide the life of the litigation [in an IPR proceeding].” *SAS Institute, Inc. v. Iancu*, 54 U.S. 357, 366-67 (2018) (emphasizing “focus on the *petitioner*’s contentions”). The statute requires a petition to identify “in writing and with particularity ... the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); accord *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). Petitioner also “may not submit new evidence or argument in reply that it could have presented earlier [in the petition], e.g., to make out a *prima facie* case of unpatentability.” Consolidated Trial Practice Guide (CTPG), 73.

The Federal Circuit has repeatedly rejected attempts to introduce new theories and evidence in Petitioner’s Reply that could have been but was not included in the

original Petition. *See, e.g., Wasica Finance GmbH v. Continental Automotive Systems, Inc.*, 853 F.3d 1272, 1286–87 (Fed. Cir. 2017) (“After Wasica pointed out the flaws of this position, Continental’s ensuing arguments to the Board and to us effectively abandoned its petition in favor of a new argument. ... Rather than explaining how its original petition was correct, Continental’s subsequent arguments amount to an entirely new theory of *prima facie* obviousness absent from the petition. Shifting arguments in this fashion is foreclosed by statute, our precedent, and Board guidelines. ... We therefore see no error in the Board declining to engage such an argument here.”) (citing 35 U.S.C. § 312(a)(3); *Intelligent Bio-Systems*, 821 F.3d at 1369–70); *Henny Penny Corporation v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019) (“We agree with Frymaster that the Board did not abuse its discretion by holding HPC to the obviousness theory in its petition. Because of the expedited nature of IPR proceedings, ‘[i]t is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” [*Intelligent Bio-Systems*, 821 F.3d] at 1369 (quoting 35 U.S.C. § 312(a)(3)). Accordingly, an IPR petitioner may not raise in reply ‘an entirely new rationale’ for why a claim would have been obvious. *See* [*Intelligent Bio-Systems*, 821 F.3d] at 1370; 37 C.F.R. § 42.23(b).”); *Intelligent Bio-Systems*, 821 F.3d at 1369 (rejecting Petitioner’s argument that the PTAB was required to “consider whether it is within

the skill of the ordinary artisan to modify the cleavage conditions to satisfy the alleged cleavage requirements” because it was raised for the first time in Petitioner’s Reply and supplemental expert declaration), (“Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.”).

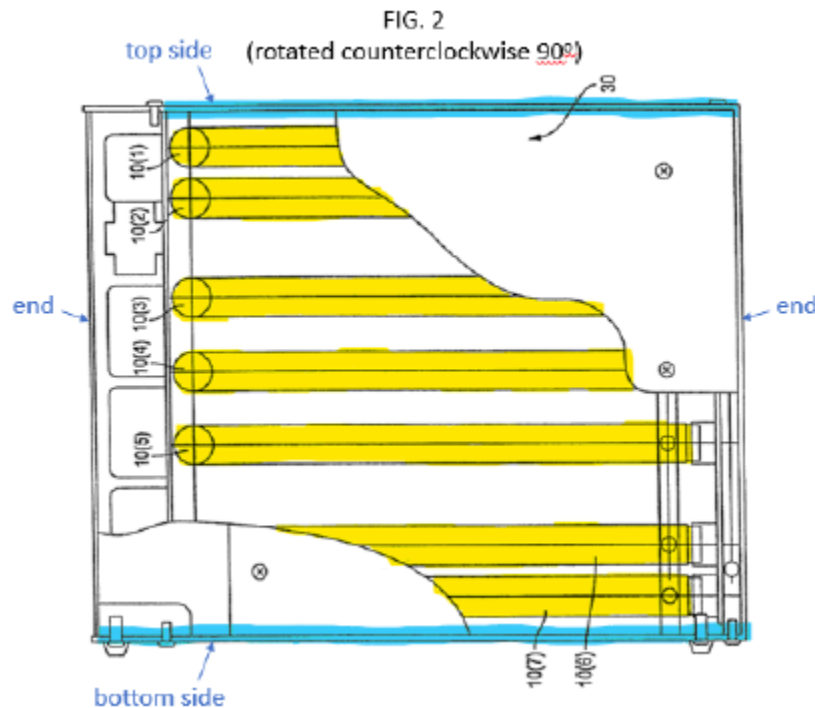
Indeed, evidence that introduces new theories in Petitioner’s Reply has been routinely excluded by the Board. *See, e.g., Duration Media LLC v. Rich Media Club LLC*, IPR2023-00953, Paper 74 (PTAB 2024), 24-29 (granting Patent Owner’s Motion to Exclude Evidence because Petitioner’s expert presented new obviousness theories in a Reply declaration) (citing 35 U.S.C. § 312(a)(3); Consolidated Trial Practice Guide (“CTPG”), 73) (explaining that a petitioner “may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.”); *Interactive Communications International, Inc. v. Blackhawk Network Inc.*, IPR2023-01235, Paper 34 (PTAB 2025), 61 (granting Patent Owner’s Motion to Exclude Evidence because Petitioner’s expert presented new opinions regarding reasonable expectation of success in a Reply declaration).

III. The New Opinion Paragraphs (Exhibit 1026) Should Be Excluded Under Federal Rule Of Evidence 403

Patent Owner moves to exclude the New Opinion Paragraphs of EX1026, submitted in conjunction with Petitioner's Reply, that introduce new obviousness theories that were not included with the Petition. *See* Reply, 10-15, 28; Patent Owner's Objections to Evidence, 1-2.¹

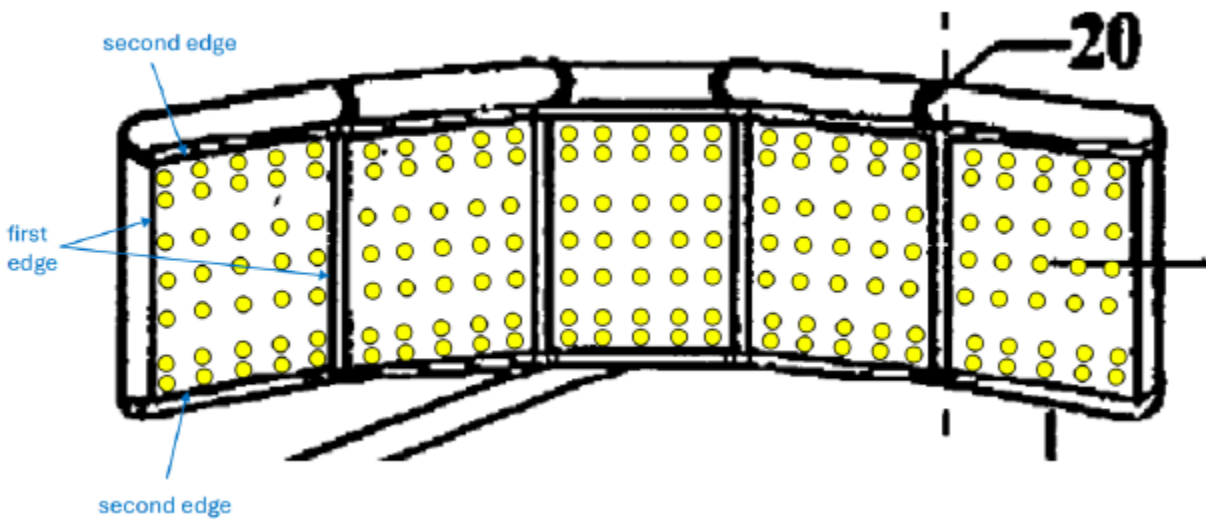
The New Opinion Paragraphs do not expand on a position taken in the Petition nor in Dr. Grove's original declaration. In his original declaration (EX1015), Dr. Grove expressly called out and relied on the "uneven" spacing of the fluorescent tubes taught by Lundahl. *See* EX1015, ¶176 (discussing spacings of 7 cm, 5 cm, and 3.5 cm between the fluorescent tubes) (citing EX1014, 6:48-54).

¹ Petitioner filed its Reply, which relies on the Supplemental Declaration of Dr. Grove (EX1026) on August 13, 2025. Patent Owner timely filed and served objections to the New Opinion Paragraphs under FRE 403 on August 20, 2025. *See* Paper 32 (Patent Owner's Objections to Evidence), 1-2; 37 CFR § 42.64(b)(1).

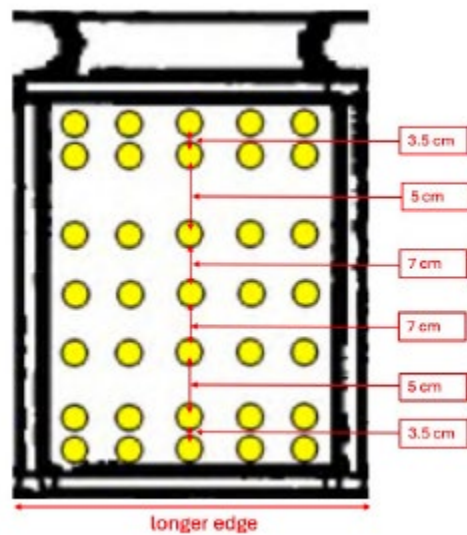


EX1015, ¶175.

And in making the proposed combination of Lundahl with Larsen, Dr. Grove replaced the fluorescent tubes with LEDs in the manner shown below. *See* EX1015, ¶177-179 (opining a “POSITA would have found it obvious and would have been motivated with a reasonable expectation of success **to incorporate the uneven spacing of light sources of Lundahl** to increase the intensity of light emitted from the second edges ... of the panels of Larson [sic] compared to regions not proximate to the second edges.”).



EX1015, ¶178. The “uneven spacing” with the specific dimensions disclosed by Lundahl is illustrated below.



POR, 25-26 (citing EX1014, 6:48-57, EX1015, ¶¶178-179).

Indeed, Dr. Grove confirmed in his deposition that he relied only on the uneven spacing of light sources of Lundahl in making his proposed combination.

See EX2084, 229:3-14 (“Q. And you’re saying that you are incorporating the uneven spacing of light sources of Lundahl, right? That’s what you say you’re doing? A. Yes.”).

But Patent Owner pointed out that “applying Lundahl’s teaching of spacing would not result in the claimed uniform illumination.” EX2050, ¶127; POR, 24-25. Indeed, achieving the claimed “uniform illumination” is not a simple feat. For example, the inventors of the ’028 Patent had difficulties achieving gap-free, uniform illumination when moving from fluorescent tubes to LEDs. *See* POR, 24-25 (citing EX2053, 100:22-101:15).

Faced with this conundrum, Petitioner and Dr. Grove changed their positions in Petitioner’s Reply and Dr. Grove’s Supplementary Declaration, respectively. Rather than relying on Lundahl’s “uneven spacing” of light sources, as was originally articulated in the Petition, Dr. Grove added new opinion testimony that a POSITA would have been able to modify the spacing of the LEDs in any manner to achieve the claimed uniformity. This new opinion testimony is discussed in ¶¶12-17 and 19 of EX1026, as explained below.

In ¶12 of EX1026, Dr. Grove provides new opinion testimony that “it is [his] interpretation that this treatment surface is consistent with what is provided in ... Lundahl, meaning that the treatment surface is at a distance of approximately 2-4” from the light-emitting surface.” He adds an additional “assumption that the lights

are intended to reflect the general spacing of lights that would be expected on an LED panel ..., whereby the LEDs have a likely lateral spacing of several centimeters or less.” The interpretation and assumption are new opinion testimony that could have been presented in Dr. Grove’s original declaration, but were not included.

In ¶13 of EX1026, Dr. Grove provides new opinion testimony that “a POSA would understand that, while LEDs placed in a ***regular row arrangement*** are discrete light sources, unlike a fluorescent tube, a row of individual LEDs would not be expected to have the gaps in illumination.” This analysis regarding placing the LEDs in a “regular row arrangement”—and ***not*** the “uneven spacing” between the rows of LEDs as originally discussed—and the impact on the illumination that such placement could have were never included in Dr. Grove’s original declaration.

In ¶14 of EX1026, Dr. Grove provides new opinion testimony that “[a]chieving a desired uniformity with LEDs is based on (a) ***the lateral spacing between individual LEDs in a given row***, (b) the ***spacing between rows*** of individual LEDs, and (c) ***the spacing between the panels*** with the LED light emitting surface and the treatment surface.” Dr. Grove further newly opines in ¶14 that because “Lundahl expressly teaches that the treatment surface is 2-4” from the light emitting surface ... the only factor that needs to be addressed is the spacing between the LEDs within each row, but this is a very straightforward process, and is easily within the skill of a POSA.” Dr. Grove’s argument that three different aspects, coupled with

the approximate distance between the light and the treatment surface, contribute to achieving a desired uniformity with LEDs, rather than only the uneven spacing between the rows of LEDs as originally described, are new and were never included in Dr. Grove's original declaration.

In ¶15 of EX1026, Dr. Grove newly opines that “a POSA would simply *ensure that the divergence angles of the adjacent LEDs overlap* at the desired treatment distance to ensure no ‘gaps’ between the light emission of the individual LEDs ... [and that] it is a simple process of replacing fluorescent tube with discrete LEDs, *ensuring overlap of adjacent divergence angles* at a distance from the treatment surface of a minimum of two inches.” In ¶16 of EX1026, Dr. Grove newly opines that “[i]t is a very straightforward process for a POSA to *space adjacent LEDs in a manner that allows the divergence angles of these LEDs to overlap* and prevent any gaps in illumination between adjacent LEDs.” In ¶19 of EX1026, Dr. Grove newly opines that “a POSA would find the determination of the specific spacing between LEDs in a row to be a straightforward task given the understanding in the art, *accounting for divergence angles* and the Lambertian distribution.” These opinions addressing the divergence angles of the LEDs between LEDs within each row, let alone the divergence angles *between the rows of LEDs* that have uneven spacing, are new and were never included in Dr. Grove's original declaration.

In ¶17 of EX1026, Dr. Grove newly opines that “even the physical *space between adjacent panels* resulting from the attachment of adjacent panels via hinges (or other means) is easily addressed by accounting for the overlap of divergence angles at a distance from the treatment surface of a minimum of two inches.” The opinion regarding a POSITA’s ability to *address the gaps between panels*, when only the uneven spacing between the rows of LEDs was originally addressed, are new and were never included in Dr. Grove’s original declaration.

In short, ¶¶12-17 and 19 of EX1026 introduce new obviousness theories that could have been included in the Petition, but were not. Petitioner’s reliance on the New Opinion Paragraphs in its Reply is unduly prejudicial to Patent Owner, and these paragraphs should be excluded.

IV. The ITC Testimony (Exhibit 1031) Should Be Excluded Under Federal Rule Of Evidence 403

Patent Owner moves to exclude the ITC Testimony, submitted in conjunction with Petitioner’s Reply, that introduces new obviousness theories. *See* Reply, 2, 24-25; Patent Owner’s Objections to Evidence, 2-3. EX1031 contains excerpts of transcripts from the ITC trial.²

² Petitioner filed its Reply, which relies on the ITC Trial Transcript Day 3 (EX1031) on August 13, 2025. Patent Owner timely filed and served objections to the ITC

The ITC Testimony does not expand on a position taken in the Petition or in either of Dr. Grove’s declarations. Specifically, Petitioner attempts to add, through Dr. Grove’s ITC Testimony, *new* theories directed to (1) the specific types of hinges that were purportedly well-known and (2) the purported “finite” number of hinges that were available to a POSITA.

First, Petitioner has presented an entirely new obviousness theory regarding the specific types of hinges that were purportedly well-known. In the Petition, Petitioner argued that a “POSITA would have found it obvious and would have been motivated with a reasonable expectation of success to locate Larsen’s hinges on the inner side surfaces of adjacent panels” because of the “nearly flush” arrangement of Larsen’s panels. Petition, 37; EX1015, ¶155. Without providing any supporting evidence other than Dr. Grove’s verbatim identical conclusory testimony (including the same “*id.*” citation recited in the Petition), Petitioner argued that this “modification would have involved nothing more than the use of a known prior art element according to known methods to yield predictable results.” Petition, 37-38; EX1015, ¶155.

Testimony under FRE 403 on August 20, 2025. *See* Patent Owner’s Objections to Evidence, 2-3; 37 CFR § 42.64(b)(1).

Patent Owner challenged Dr. Grove's conclusory opinion. As Patent Owner's expert, Dr. Jokerst, explained, "Dr. Grove does not identify a single prior art reference that discloses 'hinged structures on inner side surfaces of adjacent panels.' Nor does he provide any evidence that such a design was known to a POSITA at the time of the '028 Patent's invention or that it would work for its intended purpose in an illuminator to output uniform light for PDT applications." EX2050, ¶172; POR, 53-54.

Recognizing the lack of supporting evidence, Petitioner attempts to supplement the record by relying on Dr. Grove's belated testimony: "[t]he most common option [for connecting panels with hinges] is to put what are called *butt hinges* between the two panels" and a "POSA [would] have known that prior to 2015." EX1031, 592:2-8. Dr. Grove never identified any such butt hinges as the most common option in his original declaration, and this belatedly-presented example of a hinge that allegedly meets the claim limitation should be excluded.

Second, Petitioner attempts to cabin the allegedly known, predictable solutions to connect panels to only three potential solutions. In the Petition, Petitioner argued that "there were finite number of known, predictable solutions for Larsen's panels to be 'flexibly connected to each other through hinges,' and POSITA would have found it obvious to try placing the hinges on the inner side surfaces of the panels," relying on Dr. Grove's conclusory statement in alleged support.

Petition, 38; EX1015, ¶155. Neither Petitioner nor Dr. Grove articulated what that “finite number” would have been.

Hence, Patent Owner challenged Dr. Grove’s conclusory opinion. Dr. Jokerst explained that “Dr. Grove does not explain how or why a POSITA would have changed Larsen’s design from hinges on the bottom of the applicators 13 that were ‘flexibly connected to each other’ ... to the inner side surfaces absent hindsight. ... [because] a POSITA would have understood that these hinges could be placed in numerous locations in various orientations.” EX2050, ¶¶173-174; POR, 54-55.

Petitioner now argues that “[t]here are only *three reasonable options* for placing hinges to connect adjacent panels.” Reply, 24-25. As support, Petitioner relies on Dr. Grove’s testimony that “there are three locations to connect adjacent panels.” EX1031, 591:5-7. But Dr. Grove never identified that the finite number of known, predictable solutions for Larsen’s panels was “three” in his original declaration. Dr. Grove’s belated attempt to cabin the finite number of purported solutions to “three” is a new obviousness argument that could and should have been presented in Dr. Grove’s original declaration.

Hence, Dr. Grove’s testimony in 591:5-7 and 592:2-8 of EX1031 should be excluded as being unduly prejudicial to Patent Owner.

V. Conclusion

For the foregoing reasons, the Board should exclude ¶¶12-17, 19 of EX1026 and exclude 591:5-7, 592:2-8 of EX1031.

Case IPR2024-01312
U.S. Patent No. 11,697,028

Dated: November 5, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that a complete copy of the foregoing was caused to be served on counsel of record for the Petitioner by filing this document through PTACTS and by sending this document via electronic mail to the following addresses:

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